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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,832	07/10/2003	Yoshifumi Tanimoto	030733	8885
38834 7590 08/02/2007 WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036			EXAMINER FRINK, JOHN MOORE	
			ART UNIT 2142	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/615,832

Applicant(s)

TANIMOTO, YOSHIFUMI

Examiner

John M. Frink

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6,8,9,11-20 and 23-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-9,11-20,23-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 16 objected to because of the following informalities: the last line ends with 'and when the new mail notification is received' and then abruptly ends. It is assumed for the sake of this action that the ', and' were not intended to be present, which allows the claim to make sense grammatically and structurally. Appropriate correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 9, 11 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Chang et al. (US 6,292,825 B1), hereafter Chang.

1. Regarding claim 1, Chang discloses a mailbox which stores received electronic mail by corresponding each of the electronic mail and an electronic mail address of a destination; means for transmitting electronic mail of a new mail notification to the electronic mail address of the destination of a received electronic mail by a push method protocol (Abstract, col. 4 lines 32 – 43, Fig. 2); and

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means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination of the electronic mail stored in the mailbox (Figs. 2, 4 and 5),

wherein the means for transmitting determines whether or not to transmit the electronic mail of the new notification by the push method protocol in accordance with a type of received electronic mail (col. 4 lines 32 – 43, col. 5 lines 22 – 26, col. 6 lines 44 – 51).

2. Regarding claim 4, Chang discloses where when the electronic mail address of the destination of the received electronic mail is an electronic mail address designated in advance, the means for transmitting transmits electronic mail of a new mail notification by the push method protocol (col. 4 line 30 – col. 5 line 30).

3. Regarding claim 9, Chang discloses where the means for transmitting determines not to transmit the electronic mail of the new mail notification by the push method protocol when the received electronic mail is an electronic mail not attached with an attached file (col. 4 line 30 – col. 5 line 2).

4. Regarding claim 11, Chang discloses a mailbox which stored received electronic mail by corresponding each electronic mail and an electronic mail address of a destination (Abstract, Figs. 2, 4 and 5, col. 4 lines 32 – 43);

means for transmitting electronic mail of a new mail notification to the electronic mail address of the destination of a received electronic mail by a push method protocol; and (Abstract, Fig. 2, col. 4 lines 32 – 43)

means for distributing the electronic mail by a pull method protocol in accordance with a distribution request from the electronic mail address of the destination electronic mail stored in the mailbox (Figs. 2, 4 and 5)

wherein the means for transmitting transmits the electronic mail of the new mail notification by the push method protocol when the type of the received electronic mail is an electronic mail of a type designated in advance (col.4 lines 30 – 67).

5. Regarding claim 15, Chang discloses the means for transmitting notifies an amount of data of the received electronic mail by electronic mail of a new mail notification (col. 4 lines 60 - 67).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Boyle et al. (6,119,167), hereafter Boyle.

5. Regarding claim 5, Chang shows claim 1.

Chang does not show means for registering whether or not to carry out the new mail notification to each of a plurality of electronic mail addresses; wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering.

Boyle shows means for registering whether or not to carry out the new mail notification to each of a plurality of electronic mail addresses; wherein the means for transmitting determines whether or not to carry out a new mail notification in accordance with registered contents of the means for registering (col. 11 line 59 – col. 12 line 10).

It would have been obvious to one of ordinary skill in the art to modify the disclosure of Chang with that of Boyle in order to support additional email push and pull options and configurations, making the resulting invention more customizable to user's needs.

6. Claims 12 and 13 rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Beyda et al. (US 6,275,850 B1), hereafter Beyda.

7. Regarding claim 12, Chang discloses the mail server according to claim 11.

Chang does not disclose where pushing the attachment when the received electronic mail is an electronic mail which a file of a prescribed type is attached as an attached file.

Beyda discloses where pushing the attachment when the received electronic mail is an electronic mail which a file of a prescribed type is attached as an attached file (Fig. 3, col. 3 lines 1 – 14).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Beyda in order to allow the user to more accurately specify which emails they would like pushed to them in order to save the user the time spent downloading the attachments and well as the cost of the bandwidth utilized to download said attachments.

8. Regarding claim 13, Chang in view of Beyda further disclose claim 12.

Chang in view of Beyda et al. do not disclose where the prescribed type is an image file or a file in a format converted into character data from the image.

The examiner takes official notice that image files were notoriously old and well known at the time of the invention.

It would have been obvious to one of ordinary skill in the art to process/consider files where the prescribed type is an image file or a file in a format converted into character data from the image as said file types are commonly emailed as attachments.

9. Claims 2, 3, 6, 8 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Wakasugi et al. (US 6,823,367 B1), hereafter Wakasugi.

10. Regarding claims 2, 6 and 14, Chang discloses a mail server and mail receiving terminal devices according to claims 1, 4 and 11.

Chang does not disclose where the push method protocol is SMTP.

Wakasugi discloses utilizing SMTP (col. 5 lines 30 – 35, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Wakasugi in order to utilize an industry standard mail protocol.

11. Regarding claim 3, Chang discloses a mail server and mail receiving terminal devices according to claim 1.

Chang does not disclose where the pull method protocol is POP.

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Wakasugi discloses POP (col. 5 lines 35 – 38, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Wakasugi in order to utilize an industry standard mail protocol.

12. Regarding claim 8, Chang discloses the mail server according to claim 1, including setting a priority for which types of emails notifications should be sent (col. 4 lines 30 – 65, col. 5 lines 20 - 27).

Chang do not disclose not transmitting the electronic mail of the new mail notification by the push method protocol when the received electronic mail is a reception confirmation mail of electronic mail transmitted previously.

Wakasugi disclose the receivers of an email sending delivery confirmation messages to the senders of said email.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang involving not pushing notifications to users regarding messages that are not a high priority as defined by said user, with that of Wakasugi, which lets a sender of an email knows when the message the sent has been received so that the status important messages could be verified, in order to enable a user of Chang's disclosure to keep the capability to not receive notifications of new messages that are not of a high priority to said user, as receiving confirmation emails would otherwise result in a large increase of new email notifications (an additional email received for every email sent).

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6. Claims 16, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Haneda et al. (US 6,189,027 B1), hereafter Haneda.

7. Regarding claim 16, Chang shows an electronic mail receiving terminal device comprising means for receiving electronic mail of a new mail notification which notifies that an electronic mail is stored in a mailbox of a mail server by a push method protocol (Abstract, Figs. 2, 4 and 5, col. 4 lines 32 – 43);

means for requesting the mail server to distribute the electronic mail by a pull method protocol (Figs. 2, 4 and 5, col. 5 lines 22 – 26, col. 6 lines 44 - 51);

and means for storing the received electronic mail (Figs. 2, 4 and 5).

Chang does not show where the means for requesting request the mail server to distribute the electronic mail by the pull method protocol when an available capacity in the means for storing is a prescribed capacity or more when the new mail notification is received.

Haneda shows where the means for requesting request the mail server to distribute the electronic mail when an available capacity in the means for storing is a prescribed capacity or more when the new mail notification is received (Abstract, Fig. 4).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang with that of Haneda in order to prevent the user from attempting to download messages that would not fit on the storage medium receiving said messages, which inherently would result in a failed download attempt and thus waste the user's time and bandwidth.

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8. Regarding claims 23 and 25, Chang in view of Haneda further show means for and a device comprising means for receiving electronic mail of a new mail notification which notifies that an electronic mail is stored in a mailbox of a mail server by a push method protocol (Chang, Abstract, Figs. 2, 4 and 5, col. 4 lines 32 – 43)

means for requesting the mail server to distribute the electronic mail by a pull method protocol when receiving the new mail notification (Chang, Figs. 2, 4 and 5, col. 4 line 32 – col. 5 line 30)

comparing said size of said email with an available capacity in the means for storing when the new mail notification is received; wherein the means for requesting requests the mail server to distribute the electronic mail by the pull method protocol when the amount of data notified by the new mail notification is smaller than the available capacity in the means for storing (Haneda, Abstract and Fig. 4).

9. Claims 17, 18, 19, 20 and 24 rejected under 35 U.S.C. 103(a) as being unpatentable over Chang in view of Haneda as applied to claims 16 and 23 above, and further in view of Wakasugi.

10. Regarding claim 17, Chang in view of Haneda show claim 16.

Chang in view of Haneda do not show where the push method protocol is SMTP.

Wakasugi discloses utilizing SMTP (col. 5 lines 30 – 35, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the disclosure of Chang in view of Haneda with that of Wakasugi in order to utilize an industry standard mail protocol.

11. Regarding claims 18, 20, 24 and 26, Chang in view of Haneda and Wakasugi further disclose where the pull method protocol is a Post Office Protocol (POP) (Wakasugi, col. 5 lines 35 – 38, col. 6 lines 58 – 65, col. 17 lines 1 – 10).

13. Regarding claim 19, Chang in view of Haneda and Wakasugi further show a printing unit which prints the received electronic mail as a hardcopy; wherein the means for requesting requests the mail server to distribute electronic mail by the pull method protocol when the printing unit can execute a printing operation, and when the new mail notification is received (Wakasugi, col. 7 lines 35 – 40, col. 9 lines 11 – 54, col. 30 - 35).

Response to Arguments

12. Applicant's arguments filed 6/26/2007 regarding Chang, specifically relating to claims 1 and 11 have been fully considered but they are not persuasive. Applicant argues that Chang does not show where means for transmitting determines whether or not to transmit the email with the new mail notification by the push method protocol in accordance with a type of received electronic mail, arguing that instead Chang discloses that new mail notifications are sent automatically. However, in col. 4 lines 32 – 43, col. 5 lines 22 – 26 and col. 6 lines 44 – 51, Chang specifies where a user can set preferences as to whether or not email notifications are sent via the push method protocol.

Regarding claim 11, Applicant further argues that Chang does not make a determination of whether or not the mail is a type designated in advance in order to determine if a push notification is sent. However, in col. 4 lines 32 – 43, col. 5 lines 22 –

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26 and col. 6 lines 44 – 51, Chang specifies where a user can set preferences in advance of receiving new emails and thus notifications regarding said emails as to whether or not email notifications are sent via the push method protocol.

Thus, for at least the reasons given here and in the rejections of claims 1 and 11 above, Applicant's arguments are not persuasive.

13. Applicant's arguments addressing the rejections in view of Beyda have been fully considered and are persuasive. Therefore, the rejection has been withdrawn.

However, upon further consideration, a new ground(s) of rejection is made as detailed in the preceding section.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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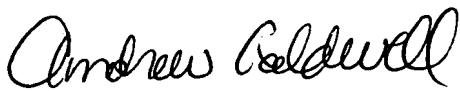
the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John M. Frink whose telephone number is (571) 272-9686. The examiner can normally be reached on M-F 7:30AM - 5:00PM EST; off alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571)272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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ANDREW CALDWELL
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